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|                                |   |                |
|--------------------------------|---|----------------|
| In re Application of           | : | DECISION ON    |
| Zoltan A. KEMENY               | : |                |
| PCT No.: PCT/US2003/021930     | : |                |
| Application No: 10/522,211     | : |                |
| Int. Filing Date: 15 July 2003 | : | PETITION UNDER |
| Priority Date: 15 July 2002    | : |                |
| Attorney's Docket No.: D-3184  | : |                |
| For: ISOLATION PLATFORM        | : | 37 CFR 1.47(b) |

This is in response to the "PETITION UNDER RULE 1.47(b)" filed on 18 November 2005. The requisite \$200 petition fee has been paid by check.

**BACKGROUND**

On 15 July 2003, applicant filed international application PCT/US2003/021930, which claimed an earliest priority date of 15 July 2002. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 15 January 2005.

On 14 January 2005, applicant filed for entry into the national stage in the United States of America. Filed with the application was, *inter alia*, the requisite basic national fee. However, no executed declaration or oath was submitted at such time.

On 17 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 18 November 2005, *inter alia*, the following:

- 1) a petition under 37 CFR 1.47(b);
- 2) the required petition fee;
- 3) Unexecuted declaration.

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1) and (3) but not items (2), and (4) - (6) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) since the petition fee has been provided by applicant.

Regarding requirement (2), section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

#### INVENTOR CANNOT BE REACHED:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.

The averments of Carlos A. Fisher are insufficient to support a finding that the nonsigning inventor, Mr. Zoltan A. Kemeny, could not be reach or locate after diligent effort because Mr. Fisher's declaration fails to show diligent effort to locate inventor Mr. Kemeny. Mr. Fisher has not shown that he has searched for the above non-signing inventor's new address by using a broad search in the internet and phone directory, which would show diligent effort by Mr. Fisher to try find Mr. Kemeny.

Regarding item (3), applicant has stated the last known address of the inventor:

Mr. Zoltan A. Kemeny  
1809 E. La Vieve Lane  
Tempe, AZ 85284

Regarding item (4) an unexecuted declaration has been provided. No one has signed on behalf for the non-signing sole inventor, Mr. Kemeny. Note MPEP 1820.

Regarding item (5) applicant has not submitted sufficient proof that applicant has sufficient proprietary interest in the application because there is no assignment from Mr. Kemeny to Vistek, Inc.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If there is no record of an assignment from Mr. Kemeny (the inventor) to Vistek, Inc., <sup>then</sup> Mr. Fisher needs to do the following. If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. Note MPEP 409.03(f)

Regarding item (6) applicant has not presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

**CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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